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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/421,055
Filing Date: April 12, 1995
Appellant(s): JOHNSON ET AL.

**MAILED
DEC 12 2007
GROUP 1700**

James D. Withers
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 13, 2007 appealing from the Office action mailed November 16, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

the earlier appeal in this application which is noted by appellants in their brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3-273975 A	MASAAKI (Japan)	12-1991
4,822,683	SCHAPPERT et al.	4-1989
4,920,182	MANSER et al.	4-1990

4,877,679	LEATHERMAN et al.	10-1989
4,892,779	LEATHERMAN et al.	1-1990
58-217516 A	ASAHI DENKA KOGYO KK (Japan)	12-1983
0 384 598 A1	JOHNSON et al. (Europe)	8-1990
1-152049 A	MATSUI (Japan)	6-1989

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

a) Claims 6, 8, 16, 17, 19-24, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application 3-273975.

See the abstract, figures, and translation: the seam of step-jointed steel automobile body plates 1 and 2 is sealed by tape 4 comprising hot-melt base film 4a such as a nylon or EVA (ethylene-vinyl alcohol) film and thermosetting resin adhesive 4b such as thermosetting epoxy resin adhesive applied on the base film at a thickness of 30 to 100 μm (0.03 to 0.1 mm), then after baking the assembly it is joined with with intercoating film 5 and overcoating film 6; the base film confines the adhesive to the seam underneath the film in order to completely seal the seam without excess adhesive outside the seal, thereby avoiding any seal finishing process and providing an attractive appearance by preventing unevenness in the film coatings (translation p. 4), the tape is thin enough to conform to the seam without showing through the coatings (translation p. 7), and the tape softens (but does not melt) during baking but hardens after cooling to ordinary temperature (translation p. 8) (therefore the base film is "dimensionally stable" by appellants' definition, specification p. 27 lines 11-19 and p. 28 lines 9-13, and could have no substantial shrinkage during the baking step due to the required even appearance of the coatings). As to claim 16, see the alternative step joint arrangement

in Figure 2. As to claims 17 and 19, see the alternative step joint arrangement in Figure 2: one of ordinary skill in the art would have expected the coating films 5 and 6 in this automobile body environment to be the typical paint layer/clearcoat layer protecting the steel automobile body plates from rust. Note that with respect to any inherent feature discussed above, the reasoning supplied in the discussion provides sufficient basis for the examiner to infer that the feature is inherent; burden is therefore shifted to applicants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02).

Appellants argue that because the entire tape of the reference does not melt it does not meet the claim limitation added to claim 6, but this is not the case: claim 6 requires only that the *melt-flowable composition* melt. Further, the disclosed flow of the adhesive implies melting of the adhesive and therefore provides sufficient basis for the examiner to infer that the adhesive in the above process also melts; burden is therefore shifted to appellants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02). Appellants also argue that the reference base film is not dimensionally stable, but this is not the case: the reference clearly discloses preventing unevenness and avoiding any seal finishing process which would be required to remove excess adhesive while assuring rust-proofing of the step joint (filling the gap of the step joint)(translation p. 4) and providing that the tape is thin enough to conform to the step joint without showing through the coatings 5 and 6 (translation p. 7), therefore during the baking step the base film cannot melt (otherwise some adhesive would flow outside the step joint, thereby failing to assure rust-proofing of the step joint and requiring the undesired seal finishing step to remove the excess adhesive) and cannot substantially shrink or wrinkle (otherwise there would be undesired unevenness showing through the film coatings 5 and 6) therefore providing sufficient basis for the examiner to infer that

the base film in the above process is also dimensionally stable; burden is therefore shifted to appellants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02).

b) Claims 6, 8, 12, 13, 16, 17, 19-24, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A.

See part a) above: it would have been obvious to one of ordinary skill in the art to follow the teachings of the reference by making the base film confine the adhesive to the seam underneath the film in order to completely seal the seam without excess adhesive outside the seal, thereby avoiding any seal finishing process and providing an attractive appearance by preventing unevenness in the film coatings (translation p. 4), and by making the base film dimensionally stable with no substantial shrinkage during the baking step in order to provide the required even appearance of the coating films. As to claims 12 and 13, oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to use such notoriously well known dimensionally stable oriented polyethylene terephthalate film as the hot-melt base film in the above method. As to claim 16, see the alternative step joint arrangement in Figure 2. As to claims 17 and 19, see the alternative step joint arrangement in Figure 2: it would have been obvious to one of ordinary skill in the art to provide the coating films 5 and 6 in this automobile body environment as the conventional paint layer/clearcoat layer protecting the steel automobile body plates from rust.

Note that appellants do not challenge the examiner's position that oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability. Appellants' "obvious-to-try" argument is not persuasive in view of the motivation set forth above and the recent Supreme Court decision in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S.

2007). Appellants' additional arguments are based on the argument that the reference base film is not dimensionally stable, which is not persuasive for the reasons noted above.

c) Claims 7, 9, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of Schappert et al. (4,822,683) and Manser et al. (4,920,182).

It is well known to blend such thermosetting epoxy resin adhesive with thermoplastic polyester resin (which is highly crystalline, making the blend semi-crystalline) in order to maintain good adhesive properties while minimize shrinkage of the adhesive upon curing and improving flexibility, as evidenced by Schappert et al. (col. 1 lines 10-55 and col. 6 lines 20-41) and Manser et al. (col. 1 lines 6-55 and col. 8 line 62 - col. 9 line 8) for example; it would therefore have been obvious to one of ordinary skill in the art to use such a well known blend as the adhesive in the above method in order to maintain good adhesive properties while minimize shrinkage of the adhesive upon curing and improving flexibility.

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to maintain good adhesive properties while minimize shrinkage of the adhesive upon curing and improving flexibility) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to the adhesive/coating/laminating arts.

d) Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of Leatherman et al. (4,877,679) and Leatherman et al. (4,892,779).

It would have been obvious to one of ordinary skill in the art to make the hot-melt base film from ultra high molecular weight microporous polyolefin because such film has the required dimensional stability (does not melt and flow) and is well suited to accept coatings such as printing inks (Leatherman et al. '679 col. 1 lines 5-10, col. 2 lines 26-35, col. 12 lines 3-44, and col. 12 line 62 - col. 13 line 3 and Leatherman et al. '779 col. 1 lines 10-15, col. 1 line 60 - col. 2 line 2, col. 11 line 47 - col. 12 line 34, and col. 12 line 52 - col. 13 line 13).

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to provide the required dimensional stability and to readily accept coatings such as printing inks) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to the adhesive/coating/laminating arts.

e) Claims 18, 29, 31, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of Manser et al. (4,920,182) and Japanese Patent Application 58-217516 A.

The only difference between the above method and the claimed method is the substantially smooth, paint-receptive film surface comprising a thermosetting epoxy-polyester blend, however the claimed thermosetting epoxy-polyester blend is well known as a paint or ink (pigmented)

composition having good adhesion and flexibility, as evidenced by Manser et al. (col. 1 lines 6-55, col. 7 lines 31-39, and col. 8 line 62 - col. 9 line 8) and JP '516 (abstract) for example; it would therefore have been obvious to one of ordinary skill in the art to use such well known paint or ink composition as the paint layer on the base film in the above method. As to claim 31, oriented polyester film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to use such notoriously well known dimensionally stable oriented polyester film as the coating film in the above method.

Note that appellants do not challenge the examiner's position that oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability.

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to provide the paint layer with good adhesion and flexibility) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to the adhesive/coating/laminating arts.

f) Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of European Patent Application 0 384 598 A1.

It is well known in such sealing tapes to provide the melt-flowable adhesive layer with an outer layer of pressure-sensitive adhesive in order to precisely position the tape and maintain the position during melt-flowing of the melt-flowable adhesive layer, as evidenced by EP '598 (p. 1 line 4 - p. 2 line 3) for example; it would therefore have been obvious to one of ordinary skill in the art to provide the melt-flowable adhesive layer in the above method with such a well known outer pressure-sensitive adhesive layer in order to precisely position the tape and maintain the position during melt-flowing of the melt-flowable adhesive layer.

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to precisely position the tape and maintain the position during melt-flowing of the melt-flowable adhesive layer) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to the adhesive/coating/laminating arts.

g) Claims 26, 27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of Japanese Patent Application 1-152049 A.

A roof ditch is a notoriously well known vehicle step joint, as evidenced by JP '049 (translation pp. 2-4 and Figures 2-5) for example; it would therefore have been obvious to one of ordinary skill in the art to use the above step joint method when making such a notoriously well known roof ditch step joint. As to claim 33, one of ordinary skill in the art would have readily recognized that the thickness of the adhesive layer or layers in such as roof ditch would have to be large enough to seal the step joint but not so large as to substantially fill the roof ditch thereby

marring the appearance of the vehicle, rendering the adhesive thickness a result-effective variable to be optimized by one of ordinary skill in the art (MPEP 2144.05(II)); it would therefore have been obvious to one of ordinary skill in the art to optimize the thickness of the adhesive to within the claimed range in the above method when making a roof ditch step joint. This is especially true since the depth of a roof ditch in an automobile is typically on the order of 10 mm, the upper limit of the claimed range.

Note that with respect to claim 33 the adhesive thickness range recited in JP '975 is merely exemplary contrary to appellants' arguments.

In response to appellants' argument that the method of JP '049 cannot be bodily incorporated into the JP '975 method, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion,

or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to apply the vehicle step joint sealing method to any vehicle step joint including a roof ditch and, with respect to claim 33, to optimize the thickness of the adhesive to within the claimed range in the above method when making a roof ditch step joint) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to roof ditch vehicle step joints.

h) Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A in view of Schappert et al. (4,822,683) and Manser et al. (4,920,182) as applied to claims 7, 9, and 28 above, and further in view of Japanese Patent Application 1-152049 A.

A roof ditch is a notoriously well known vehicle step joint, as evidenced by JP '049 (translation pp. 2-4 and Figures 2-5) for example; it would therefore have been obvious to one of ordinary skill in the art to use the above step joint method when making such a notoriously well known roof ditch step joint.

In response to appellants' argument that the method of JP '049 cannot be bodily incorporated into the JP '975 method, the test for obviousness is not whether the features of a

secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to apply the vehicle step joint sealing method to any vehicle step joint including a roof ditch) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977

F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to roof ditch vehicle step joints.

i) The other rejections of the instant claims in the final rejection are upon reconsideration considered to be cumulative and therefore, in the interest of simplifying the issues for appeal, are hereby withdrawn in favor of the rejections set forth above.

(10) Response to Argument

rejection a)

Appellants argue that because the entire tape of the reference does not melt it does not meet the claim limitation added to claim 6, but this is not the case: claim 6 requires only that the *melt-flowable composition* melt. Further, the disclosed flow of the adhesive implies melting of the adhesive and therefore provides sufficient basis for the examiner to infer that the adhesive in the above process also melts; burden is therefore shifted to appellants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02). Appellants also argue that the reference base film is not dimensionally stable, but this is not the case: the reference clearly discloses preventing unevenness and avoiding any seal finishing process which would be required to remove excess adhesive while assuring rust-proofing of the step joint (filling the gap of the step joint)(translation p. 4) and providing that the tape is thin enough to conform to the step joint without showing through the coatings 5 and 6 (translation p. 7), therefore during the baking step the base film cannot melt (otherwise some adhesive would flow outside the step joint, thereby failing to assure rust-proofing of the step joint and requiring the undesired seal finishing step to remove the excess adhesive) and cannot substantially shrink or wrinkle (otherwise there would be undesired unevenness showing through the film coatings 5 and 6) therefore providing sufficient basis for the examiner to infer that

the base film in the above process is also dimensionally stable; burden is therefore shifted to appellants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02).

rejection b)

See the response for rejection a) above. Also, note that appellants do not challenge the examiner's position that oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability. Further, appellants' "obvious-to-try" argument is not persuasive in view of the motivation set forth above and the recent Supreme Court decision in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Finally, appellants' additional arguments are based on the argument that the reference base film is not dimensionally stable, which is not persuasive for the reasons noted above.

rejection c)

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to

combine the references (to maintain good adhesive properties while minimize shrinkage of the adhesive upon curing and improving flexibility) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to the adhesive/coating/laminating arts.

rejection d)

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to provide the required dimensional stability and to readily accept coatings such as printing inks) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to the adhesive/coating/laminating arts.

rejection e)

Note that appellants do not challenge the examiner's position that oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability.

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to provide the paint layer with good adhesion and flexibility) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to the adhesive/coating/laminating arts.

rejection f)

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to precisely position the tape and maintain the position during melt-flowing of the melt-flowable adhesive layer) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not,

then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to the adhesive/coating/laminating arts.

rejection g)

Note that with respect to claim 33 the adhesive thickness range recited in JP '975 is merely exemplary contrary to appellants' arguments.

In response to appellants' argument that the method of JP '049 cannot be bodily incorporated into the JP '975 method, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to apply the vehicle step joint sealing method to any vehicle step joint including a roof ditch and, with respect to claim 33, to optimize the thickness of the adhesive to within the claimed range in the above method when making a roof ditch step joint) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to roof ditch vehicle step joints.

rejection h)

In response to appellants' argument that the method of JP '049 cannot be bodily incorporated into the JP '975 method, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references (to apply the vehicle step joint sealing method to any vehicle step joint including a roof ditch) is clearly set forth in the rejection.

In response to appellants' argument that the secondary references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references and the claimed invention all pertain to roof ditch vehicle step joints.

rejection i)

Appellants' arguments pertaining to the other rejections of the instant claims in the final rejection are moot because upon reconsideration these rejections are considered to be cumulative and therefore, in the interest of simplifying the issues for appeal, are hereby withdrawn in favor of the rejections set forth above.

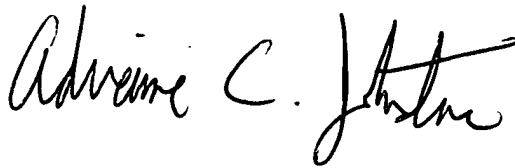
(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided in appellants' brief.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Adrienne Johnstone



Conferees:

Richard Crispino



Romulo Delmendo

